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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,475	06/04/2001	Louis Dischler	2060G	5759

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Milliken & Company  
P.O. Box 1927  
Spartanburg, SC 29304

EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/25/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/873,475

Applicant(s)

DISCHLER ET AL.

Examiner

Jenna-Leigh Befumo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendment*

1. Amendment A, submitted as Paper No. 4 on May 12, 2003, has been entered. Claims 1 - 24 have been cancelled. Claims 25 - 48 have been added. Therefore, the pending claims are 25 - 48.

2. The cancellation of claims 1 - 24 have rendered moot the rejections to those claims set forth in the previous Office Action. However, new rejections are set forth below.

### *Terminal Disclaimer*

3. The terminal disclaimer filed on May 13, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,112,381, US Patent 6,230,376, and US Patent Application 09/777,444 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### *Claim Rejections - 35 USC § 112*

4. Claims <sup>5</sup>2~~4~~ - 48 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The step of immobilizing the fibers prior to nicking the fibers is critical or essential to the practice of the invention, but not included in the claims. Therefore, the claims are not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The Applicant's invention is based on the fact that the fibers are immobilized prior to the nicking step. It is only by immobilizing the fibers prior to nicking that the fabric is able to retain the strength properties and have the improved pilling properties. Since the specification does not disclose any other method or treatment which produces the pile fabric with the claimed properties without immobilizing the fibers, the claim as written is not enabled by the specification.

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5. Claims 25 – 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 25 – 48 are indefinite because they fail to set forth the composition or structure of the fabric that produces the claimed properties of the strength ratio and piling. Claims that merely set forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future. Ex parte Slob (PO BdApp) 157 USPQ 172.

While that Applicant argues (Amendment A, page 6) that amendments limiting the fibers to being nicked instead of abraded and limiting the woven fabric to yarns made from polyester, cotton, and blends thereof should be sufficient to define the product's structure, it is felt by the Examiner that these limitations do not by themselves produce the claimed properties. The claims are rejected since they do not define the structure which produces the claimed strength ratio and pilling properties. Would any woven fabric made from yarns having polyester, cotton, and blends thereof, and a pile surface created by fibers extending from the surface of the fabric inherently have the claimed fill tensile strength? While the limitation that the fabric is made from yarns having polyester, cotton, and blends thereof does further define the structure of the woven fabric, it is not this structural limitation that produces that claimed properties.

Additionally, the fact that the fabric is nicked, by itself does not distinguish the structure over abraded or sanded fabrics. The term "nicked" is a method limitation which is interpreted based on the final product which is produced by the method, a plurality of pile fibers on the surface of the fabric. Thus, the Applicant has not clearly defined the structure which produces this

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property, but instead tries to define the product by claiming the properties that the final product has, which makes the claim indefinite.

7. Claims 45 – 48 are rejected as being indefinite. It is unclear what the Applicant is comparing the mechanically treated fabric to. What structure does a mechanically treated fabric that does not exhibit a nicked appearance have? By mechanically treated does the Applicant mean any mechanical treatment such as calendaring, embossing shearing, or needling? And is a “nicked appearance” any fabric which has a napped surface? If not how is a “nicked appearance” different from the appearance of a napped fabric? For purposes of examination, nicked appearance is defined as the appearance of any napped or sueded fabric.

***Claim Rejections - 35 USC § 102/103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 25 – 48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Willbanks (5,080,952).

The features of Willbanks have been set forth in section 12 of the previous Office Action. Willbanks discloses a woven fabric which produces a napped pile without weakening the fabric strength in either the warp or fill direction. The fabric can also be a warp faced twill fabric made from a polyester/cotton blend. The napping process would produce the same structure as the nicking limitation since the napped and nicked fabric would both have short fibers extending from the surface of the fabric to create a pile.

Even though Willbanks discloses that the method of abrading the surface results in stronger fill yarns than other abrading process (column 3, lines 33 – 35), Willbanks does not explicitly teach the limitations of retained fill tensile strength or degree of pilling. However, it is

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reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. twill weave fabrics made from 65/35 polyester/cotton yarns) and in the similar production steps (i.e. abrading the surface of the fabric) used to produce a plush, napped fabric. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed limitations would obviously have been provided by the process disclosed by Willbanks. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Therefore, claims 25 – 48 are rejected.

10. Claims 25 – 30, 33, 34, 37, 38, 41, 42, and 45 – 48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Otto (4,468,844).

The features of Otto have been set forth in section 11 of the previous Office Action. Otto discloses woven twill or plain weave fabrics made from cotton, polyester, and blends thereof can be mechanically finished to produce a napped surface. The napping process would produce the same structure as the nicking limitation since the napped and nicked fabric would both have short fibers extending from the surface of the fabric to create a pile.

Although Otto does not explicitly teach the limitations of fill tensile strength or the degree of pilling, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. woven fabrics made of blended polyester/cotton yarns) and in the similar production steps (i.e. abrading the surface of the fabric) used to produce the napped fabric. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed limitations would obviously have been provided by the process disclosed by Otto. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the

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rejection made above under 35 USC 102. Thus, claims 25 – 30, 33, 34, 37, 38, 41, 42, and 45 – 48 are rejected.

***Claim Rejections - 35 USC § 103***

11. Claims 31, 32, 35, 36, 39, 40, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otto.

The features of Otto have been set forth above. Although Otto discloses that various types of fabrics including twill weave fabrics can be abraded, Otto fails to teach using warp-faced twill weave fabrics. However, it would have been obvious to one having ordinary skill in the art to choose a warp-faced twill weave, since it is within the general skill of a worker in the art to select a known type of twill structure, and would only involve routine skill in the art. Further, one of ordinary skill would have been motivated to choose a warp-faced twill fabric since warp-faced fabrics are commonly used in popular garments and upholstery fabrics such as denim and gabardine. Therefore, claims 31, 32, 35, 36, 39, 40, 43, and 44 are rejected.

***Response to Arguments***

12. The Applicant's arguments, filed May 12, 2003, have been fully considered, but are not persuasive. The Applicant argues that Otto would not nick the surface fibers, but instead sands the fabric's surfaces which essentially pulls out the surface fibers (Amendment A, pages 7). First, it is noted that based on the specification, nicking can be preformed by napping or sanding the surface of the fabric (Specification, page 1). The fibers are nicked, or in other words broken, by either sanding, abrading, or napping the fabric's surface. While the Applicant's specification performs this "nicking" process on immobilized fibers, there is nothing in the claim which states that the fibers are immobilized when they are nicked and there is nothing in the specification which states the "nicked" fibers can only be produced when the fibers are immobilized. Sanding

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and napping would also break the fiber away from the surface of the fabric and produce a pile fabric. Therefore, the Examiner does not feel that the term nicking by itself distinguishes the claimed fabric from the prior art.

Second, these limitations are method limitations. Even though the claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product which is claimed is the same or an obvious variant from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. The burden has been shifted to the Applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). In this case, both final products would be a woven fabric having a pile surface. The pile fibers whether formed by nicking or sanding would still have ends extending in a direction perpendicular to the fabric's surface to form a pile surface. Thus, structurally the fabrics are the same. The Applicant has not provided any evidence which establishes that the fabric produced by Otto would not have the claimed properties. Therefore, the rejections based on Otto are maintained.

13. The Applicant also argues that Willbanks does not read on the claimed invention, since the fibers are not nicked and Willbanks does not teach using immobilized fibers (Amendment A, pages 7 - 8). However, as set forth above, the patentability is determined by the structure of the final product. And again, both the prior art and the invention would produce a final product comprising a woven fabric have short pile fibers with cut ends. Therefore, the term nicking is a method limitation which produces a final product having pile surface. Further, the Applicant does not claim the fibers are immobilized when the fabric is nicked. And, even if the fibers were nicked when the fabric was nicked would the fibers be immobilized in the final product? The



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immobilization step is a method limitation which is not given positive weight at this time since it is not recited in the claims.

Further, while it is agreed that the methods used to produce the pile fabrics in this case are clearly different, it is not agreed that the products produced are at all structurally different. The Applicant has failed to clearly distinguish that the product claimed is structurally different from the prior art. Whether the pile surface is produced by hydroentangling or nicking immobilized surface, both final products would have pile fibers extending from the surface of the fabric. The Applicant even admits that the hydroentanglement process pushes fibers away from the surface of the fabric to produce a pile surface (Amendment A, page 8). This is the same structure produced by "nicking" the fabric, i.e., the nicked fibers extend from the surface of the fabric to produce a pile surface. The Applicant's additional arguments that the hydroentangled fabric would not have the same high tensile strength retention and pilling characteristics (Amendment A, page 8) are not persuasive since the Applicant has provided no evidence to establish that the hydroentangled fabric would indeed not have the claimed properties. In fact, Willbanks teaches that the hydroentanglement method produces a pile surface without the degree of weakening of fabric strength associated with other napping techniques (column 3, lines 10 – 12). Therefore, the burden is on the Applicant to provide evidence which proves otherwise. Thus, the rejections base on Willbanks are maintained.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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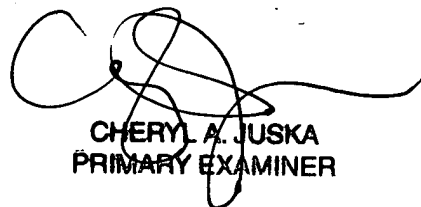
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo  
June 18, 2003



CHERYL A. JUSKA  
PRIMARY EXAMINER